



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,546	03/26/2004	David R. McCormick	M6257RE	9366
423	7590	10/10/2007	EXAMINER	
HENKEL CORPORATION 1001 TROUT BROOK CROSSING ROCKY HILL, CT 06067			GREEN, ANTHONY J	
			ART UNIT	PAPER NUMBER
			1793	
			MAIL DATE	DELIVERY MODE
			10/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/810,546

**Applicant(s)**

MCCORMICK ET AL.

**Examiner**

Anthony J. Green

**Art Unit**

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1755

***Reissue Applications***

***Improper Recapture***

1. Claims 23-30 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the office action mailed 01/24/2005, 102(b) rejections to US patent 4,749,418 to Saeki and WO 91/05078 were made by the examiner. In applicant's response of 09/23/05, applicant came in and cancelled all of the original claims, basically narrowing the range of hexavalent chromium and trivalent chromium and arguing that the prior art relied upon taught amounts of chromium outside of the claimed range. Accordingly it

Art Unit: 1755

appears that the record clearly shows that applicant previously surrendered during the prosecution of the application and therefore there is an issue of improper recapture.

Applicant argues that the error identified in the Supplemental Reissue Declaration, filed September 23, 2005, obviates this recapture rejection where an actual mistake in considering and responding to the rejections of pending claims was made in the response to the April 9, 2001 Official Action and that the issued claims of this patent are being amended to add a wholly separate component in order to establish patentability of the very claims submitted in response to the April 9, 2001 rejection. Certainly Applicants' representative did not purposefully submit claims having range limitations of hexavalent chromium and trivalent chromium known to be inadequate to obviate all rejections cited by the Patent Office. Applicant further argues that the rule is avoided by satisfaction of the third element of the Federal Circuit test where the same feature broadened has also been narrowed in these claims.

To this argument the examiner respectfully disagrees. Merely arguing that all of the claim rejections were not addressed by applicants is not sufficient to avoid the recapture rule as the prosecution history of the patent under reissue clearly shows that applicant's narrowed the range of the hexavalent chromium and trivalent chromium to avoid the art rejections. Whether or not all of the art rejections were previously argued has not merit on the recapture rule. It is impermissible recapture for a reissue claim to be as broad or broader in scope than any claim that was canceled or amended in the original prosecution. Claim scope that was canceled or amended is deemed surrendered and therefore barred from reissue even if it includes other limitations

Art Unit: 1755

making the reissue claims narrower than the patent claims in other aspects. See MPEP 1412.02. Accordingly the rule of improper recapture is still seen to apply.

### ***Oath/Declaration***

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

As stated previously "Merely stating that "applicant's attorney failed to appreciate the full scope of the invention where claims of narrower scope in some aspects and broader scope in other aspects were not added by said amendment" is not sufficient.

Applicant argues that the statement in the declaration is sufficient.

To this argument the examiner respectfully disagrees. See MPEP 1414, section II, which states that the error must specifically be identified. It is sufficient that the reissue oath identify a single word, phrase or expression in the claim and how it renders the original patent inoperative or invalid. Clearly applicant's declaration does not meet this criteria and accordingly it is defective.

### ***Claim Rejections 35 USC 251***

3. Claims 23-30 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim

Art Unit: 1755

is broadened if it is broader in any one respect even though it may be narrower in other respects.

Specifically note that newly added independent claims 23 and 26-27 recite the limitation that component (C), the hexavalent chromium, is present in an amount of about "0.3 g/l to about 30 g/l", compared with 0.5 to 3.5 recited in all of the patent claims. Also, note that the amount of component (D), the trivalent chromium cations is broader in the newly added claims compared with the patent claims.

The same holds true with respect to newly added claim 28 wherein applicant has added the source of the components along with the addition of a surfactant.

4. Claims 1-30 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

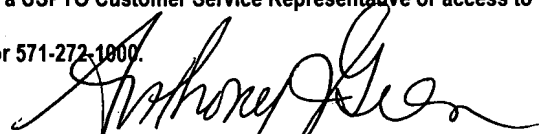
Art Unit: 1755

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1800.



Anthony J. Green  
Primary Examiner  
Art Unit 1755

ajg  
September 3, 2007